

Remarks

Claims 1-21 are pending in the application. The Office Action rejected claims 1-21 as being obvious under 35 U.S.C. § 103(a) citing US Patent No. 7,010,351 (hereafter “Firlik”) in view of US Patent No. 5,738,625 (hereafter “Goluk”). Applicants respectfully request allowance of all the pending claims in view of the subsequent remarks.

Applicants first submit that, for a *prima facie* case of obviousness, the cited prior art references (when combined) “must teach or suggest all the claim limitations” MPEP § 2143. Thus, if the combination of references does not teach each of the claimed limitations, a finding of obviousness fails. In addition, the Patent Office has the burden under § 103 to establish a *prima facie* case of obviousness, which can be satisfied only by showing some objective teaching in the prior art would lead one to combine the relevant teachings of the references. *See In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). As such, an Applicant, to overcome an allegation of obviousness can show that the cited prior art references (when combined) do not teach or suggest all the claim limitations or that there is not an objective teaching in the prior art that would lead one to combine the relevant teachings of the references.

Applicants note that the Office Action on page 2 merely states, “Firlik teaches all of the subject matter of the above claims except for the mention of magnetic coils.” Firlik is directed toward a wholly different approach of neural stimulation, electricity. The present claims are directed toward a novel and non-obvious use of transcranial magnetic stimulation (TMS). The Office Action states that Gluck provides the use of magnetic coils and that the combination of Firlik and Gluck render the present claims unpatentable. Applicants respectfully disagree. Applicants cannot find where in Firlik each and every claim limitation is taught. Similarly, Applicants cannot find where in Gluck each and every claim limitation is taught. Finally, Applicants cannot find wherein in the combination of Firlik and Gluck, each and every claim limitation is taught. Applicants request a more specific statement of where and how the cited references teach the claim limitations, so as to engage the Patent Office in a meaningful dialogue.

Second, the Supreme Court has reaffirmed the *Graham* factors for determination of obvious under 35 U.S.C. 103(a). *KSR Int’l Co. v. Teleflex, Inc.* (KSR), No 04-1350 (U.S. Apr. 30, 2007). The four factual inquiries under *Graham* require examination of: (1) the scope and contents of the prior art; (2) the differences between the prior art and the claims in issue; (3) the

level of ordinary skill in the pertinent art; and (4) the objective evidence of secondary consideration. *Graham v. John Deere (Graham)*, 383 U.S. 1, 17-18, 149 USPQ 459, 467 (1966); see also 35 U.S.C. § 103 (2000).

The Court has further recognized that the requirement for a teaching, suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, which was established by the Court of Customs and Patent Appeals, provides a helpful insight for determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a). In addition, the Court maintained that any analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it is “important to identify reasons that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed, because “inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *KSR* at 14, 15.

Where an invention is contended to be obvious based upon a combination of elements across different references, one should be able to identify particular reasons that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements. *See, KSR Int’l Co.*, at 14, 15. This requirement prevents the use of “the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.” *Ecolochem, Inc. v. So. Cal. Edison Co.*, 227 F.3d 1361, 1371-72 (Fed. Cir. 2000) (quoting *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999)).

Applicants respectfully put forth that there is no motivation to combine the references cited in the manner described in the Office Action. Furthermore, the cited references teach away from their combination. Applicants point to Firlik, column 3, lines 31-48:

Although TMS appears to be able to produce a change in the underlying cortex beyond the time of actual stimulation, TMS is not presently effective for treating many patients because the existing delivery systems are not practical for applying stimulation over an adequate period of time. TMS systems, for example, are relatively complex and require stimulation treatments to be performed by a healthcare professional in a hospital or physician’s office. TMS systems also may not be reliable for longer-term therapies because it is difficult to (a) accurately localize the region

of stimulation in a reproducible manner, and (b) hold the device in the correct position over the cranium for a long period, especially when a patient moves or during rehabilitation. Furthermore, current TMS systems generally do not sufficiently focus the electromagnetic energy on the desired region of the cortex for many applications. As such, the potential therapeutic benefit of TMS using existing equipment is relatively limited.

Firlik clearly characterizes TMS as not effective, not practical, not reliable and limited in benefit. Accordingly, a proper prima facie case of obviousness has not been presented. The rejections should be withdrawn for at least this reason. Applicants submit that the current construction of the cited references in the manner provided in the Office Action is contrary to the teachings of the cited references. Furthermore, if one were to combine the systems of the two cited references, the resulting system would be wholly inoperable because there are no teachings in either reference on how to modify the TES system of Firlik to incorporate a magnetic coil. Such a modification is beyond the capacity of one of ordinary skill in the art. Applicant respectfully requests withdrawal of this rejection.

Firlik in combination with Gluck does not anticipate nor render obvious any of the pending claims. Thus, Applicants respectfully request allowance of all the pending claims in view of the previous remarks. The Examiner is invited and encouraged to contact directly the undersigned if such contact may enhance the efficient prosecution of this application to issue.

A fee of \$525.00 for a three month extension of time fee (large entity) is enclosed. The Commissioner is hereby authorized to apply this fee and any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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